

Remarks

The Applicant does not believe that examination of the response contained herein will result in the entry of new matter to the present application for invention. Accordingly, the Applicant respectfully requests that the foregoing response be considered and the claims to the present invention be, kindly, reconsidered.

The March 3, 2004 Office Action has been received and considered by the Applicant. Claims 31, 40, 41, 50, 51, 56, 58, 63, 64, 79, 80 and 94 stand rejected by the March 3, 2004 Office Action. Claims 32-39, 42-49, 52-55, 57, 59-61, 65-78, 81-93 and 95 are objected to as being dependent upon a base claim, but would be allowable if rewritten in independent form.

The Examiner objects to the term "at last" within Claim 57. This term has been changed to "at least" by the foregoing amendment, as suggested by the Examiner.

The March 3, 2004 Office Action rejects Claims 31, 40, 41, 50, 51, 56, 58, 63, 64, 79, 80 and 94 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1, 16 and 23 of U.S. Patent No. 6,353,580. The Applicant respectfully points out that U.S. Patent No. 6,353,580 issued from the parent application to the present invention and therefore, cannot be used as prior art. The only reference in this rejection is the parent case (U.S. Patent No. 6,353,580). With respect to Claims 1, 16 and 23 of U.S. Patent No. 6,353,580, there is no disclosure or suggestion for accessing various audio items on the unitary storage medium using either the TOC access mechanism or the file-based access mechanism as recited by the rejected claims. The Applicant respectfully submits that accessing various items on the storage medium using either the TOC access mechanism or the file-based access mechanism are novel and unobvious over Claims 1, 16 and 23 of U.S. Patent No. 6,353,580.

The Applicant respectfully submits that the parent case of the present invention (U.S. Patent No. 6,353,580) can be used as a basis for a double patenting rejection, but cannot be treated as prior art. In making the aforementioned obvious-type double patenting rejection, the examiner inherently states that the rejected claims to the present invention differ from that of that of U.S. Patent No. 6,353,580 (the parent case) because, simply put, a same-invention, double patenting rejection has not been made. The Office Action alleges that the claims to the present invention are obvious in view of the claims to U.S. Patent No. 6,353,580, however, the Examiner has cited no prior art, whatsoever, showing that the

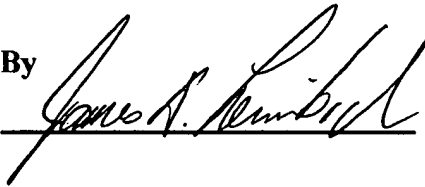
differences between the rejected claims of the present invention and the claims to U.S. Patent No. 6,353,580 amount to an obvious modification of Claims 1, 16 and 23 of U.S. Patent No. 6,353,580. Without a prior art recitation to substantiate an obvious-type double patenting rejection, there is no factual basis upon which the assertion of obviousness can be measured. Therefore, the double patenting rejection cannot stand.

The Applicant respectfully points out that In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968) should not apply to the present case. In re Schneller is applicable to situations where the subject matter recited in the claims of the application is fully disclosed and **covered** by a claim in the patent. The claims to the present application for invention recite subject matter that is not fully covered by the claims to U.S. Patent No. 6,353,580. The real issue that could be present here is domination not “obviousness” type double patenting. Domination is where one claim covers a later claim, which is not double patenting. In re Kaplan, 789 F.2d 1574, 1577, 229 USPQ 678, 681 (Fed. Cir. 1986). In re Schneller does not support the proposition that obviousness-type double patenting exists without any obviousness analysis when the application claim recites elements in addition to those recited in the patent claims. In the present case, there has been no obviousness analysis.

Applicant is not aware of any additional patents, publications, or other information not previously submitted to the Patent and Trademark Office which would be required under 37 C.F.R. 1.99.

In view of the foregoing amendment and remarks, the Applicants believe that the present application is in condition for allowance, with such allowance being, respectfully, requested.

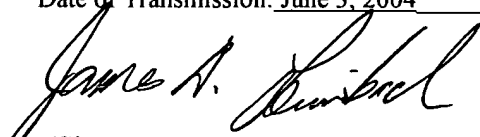
Respectfully submitted,

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